

REMARKS

The claims have been amended to remedy the § 112 rejections. No new matter has been added.

Examiner's indication of the allowability of the subject matter of claims 15 – 17 is acknowledged with appreciation. Claim 15 has been amended into independent format and therefore claims 15 – 17 are now in allowable form.

New claims have been added, but those new claims substantially reiterate the subject matter of the claims originally submitted. Certain changes have been made to their order for purposes of allowance. The limitations of the claims have, however, been differently recited to more clearly define the claimed invention. Specifically, each of the independent claims 22, 28 and 36 recite arrangements for detecting X-ray radiation and include recitations defining sensor planes of the detectors that are parallel to a surface of the carrying member, and the carrying member is arranged so that the sensor plane is angularly oriented otherwise than perpendicular to incident X-ray beams.

Examiner has previously cited Schiebel et al. '072 (claim 1) and Schick et al. '782 (claim 1, 2, 4, and 5) under 35 USC 102. In each rejection, however, Examiner states that "[i]t is inherent to one skilled in the art to arrange a sensor plane in an angle incident to x-ray beams." Initially, each of the presently presented independent claims more clearly specify that the relevant orientation is not just at an angle to incident X-ray beams, but *sensor planes of the detectors are oriented parallel to a surface of the carrying member*, and the carrying member is *angularly oriented otherwise than perpendicular* to incident X-ray beams. Furthermore, Examiner's reliance on "inherency" is misplaced. According to MPEP 2112 (page 2100-51):

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that

the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). . . .

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Examiner has not carried this burden. For these reasons, the rejections under 35 USC 102 are respectfully traversed.

In paragraph 10 of the Official Action, Examiner cites Schick et al. '782, but admits that it fails to disclose a majority of the claimed subject matter. Examiner then takes official notice of a substantial entirety of the claimed subject matter. Applicant respectfully traverses this rejection and a demand for evidence according to MPEP 2144.03 is hereby made. In this regard, MPEP 2144.03 states:

2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art

If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to

contradiction or explanation by the affidavits of the applicant and other persons. See 37 CFR 1.104(d)(2).

Applicant must seasonably challenge well known statements and statements based on personal knowledge when they are made by the Board of Patent Appeals and Interferences. *In re Selmi*, 156 F.2d 96, 70 USPQ 197 (CCPA 1946); *In re Fischer*, 125 F.2d 725, 52 USPQ 473 (CCPA 1942). See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971).

For further views on official notice, see *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970) ("[A]ssertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work" and "allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported." Furthermore the applicant must be given the opportunity to challenge the correctness of such assertions and allegations. ***"The facts so noticed serve to 'fill the gaps' which might exist in the evidentiary showing" and should not comprise the principle evidence upon which a rejection is based.***). See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971) (scientific journal references were not used as a basis for taking judicial notice that controverted phrases were art-recognized because the court was not sure that the meaning of the term at issue was indisputable among reasonable men); and *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of [judicial] notice.").

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for

evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made. This is necessary because the examiner must be given the opportunity to provide evidence in the next Office action or explain why no evidence is required. If the examiner adds a reference to the rejection in the next action after applicant's rebuttal, the newly cited reference, if it is added merely as evidence of the prior well known statement, does not result in a new issue and thus the action can potentially be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final.

Finally, Examiner's assertion that Schick et al.'s figure 4c makes obvious a parallel orientation of the sensor array to striking incident X-ray beams is not supportable. That figure is reproduced immediately below.

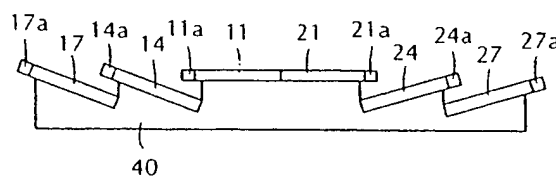
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FIG. 4C



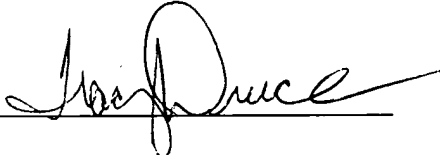
There is no disclosure, teaching, or even a suggestion to make such a modification as required for a obviousness rejection under 35 USC 103. The disabled situation Examiner references is not addressed in the Schick et al. patent; therefore, there can be no disclosure, teaching or suggestion of the same.

It is believed that the above amendments and remarks overcome the Examiner's objection and rejection of the claims under 35 U.S.C. §§ 102, 103 and 112 as indicated hereinabove. Withdrawal of the rejections of the claims is therefore respectfully requested. Allowance of the claims is believed to be in order and such allowance is respectfully requested. In the event that Examiner believes that a telephone interview might hasten the present application to issuance, Examiner is invited to contact the undersigned at the indicated contact numbers.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Tracy W. Druce", is written over a horizontal line.

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